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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/749,639	12/28/2000	Surendra Goel	06975-076001/Search 01	4918
26171	7590	11/12/2003	EXAMINER	
FISH & RICHARDSON P.C. 1425 K STREET, N.W. 11TH FLOOR WASHINGTON, DC 20005-3500			NGUYEN, CINDY	
			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/749,639	GOEL ET AL.
	Examiner Cindy Nguyen	Art Unit 2171

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 24 September 2003.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-32 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-32 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 28 December 2000 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

This is in response to request for amendment filed 09/24/03.

### 1. *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

**2. Claims 1-13, and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Wical et al. (U.S 6385602) (Wical).**

Regarding claims 1 and 21, Wical discloses: A method and a computer program for performing a category search to identify categories of items that relate to a search term, the method comprising:

receiving at least one search term, wherein the search term includes at least one search term word (col. 18, lines 19-35, Wical);

comparing the search term with a hierarchy of category identifiers to determine whether matches exist (col. 18, lines 51-67, Wical), wherein comparing the search term with the hierarchy of category identifiers includes comparing the search term word with one or more words in the hierarchy of category identifiers (col. 18, lines 51-67, Wical);

comparing the search term word with terms related to one or more categories to determine whether matches exist (col. 19, lines 1-44, Wical); and

displaying at least a category identifier based on the matches that are determined to exist between the search term word and the words of the hierarchy of category identifiers, and between the search term word and the terms related to one or more categories (col. 25, lines 9-53, Wical).

Regarding claim 2, all the limitations of this claim have been noted in the rejection of claim 1. In addition, Wical discloses: receiving at least one search term comprises:

receiving several search terms (col. 8, lines 39-54, Wical), and  
grouping the search terms received as a single string (col. 9, lines 60 to col. 10, lines 30, Wical);

comparing the search term with the hierarchy of category identifiers comprises  
comparing the single string of search terms with the hierarchy of category identifiers to determine whether matches exist (col. 10, lines 13-61, Wical); and

comparing the search term with the terms related to one or more categories  
comprises comparing the single string of search terms with the terms related to one more categories to determine whether matches exist (col. 10, lines 62 to col. 11, lines 21, Wical).

Regarding claim 3, all the limitations of this claim have been noted in the rejection of claim 1. In addition, Wical discloses: wherein the terms related to one or more categories include a name and a description of a web site corresponding to a category (fig. 10c and 11A and corresponding text, Wical).

Regarding claim 4, all the limitations of this claim have been noted in the rejection of claim 1. In addition, Wical discloses: wherein the hierarchy of category identifiers comprises an ordered list of category names arranged in order from broad categories to narrow categories with the narrowest category being a final category name (col. 27, lines 14-33, Wical).

Regarding claim 5, all the limitations of this claim have been noted in the rejection of claim 1. In addition, Wical discloses: wherein displaying at least a category identifier includes communicating at least a category identifier based on the matches that are determined to exist with the hierarchy and the terms (fig. 10A, 10B and corresponding text, Wical).

Regarding claim 6, all the limitations of this claim have been noted in the rejection of claim 1. In addition, Wical discloses: wherein displaying at least a category identifier includes displaying several category identifiers (fig. 10A, 10B and corresponding text, Wical), the method further comprising ranking the category identifiers based on a number of the matches that are determined to exist and at least one of locations and types of the matches (col. 25, lines 27-53, Wical).

Regarding claim 7, all the limitations of this claim have been noted in the rejection of claim 6. In addition, Wical discloses: wherein ranking the category identifiers based on the location of the matches includes ranking the category identifiers based on the relative location of the matches within the hierarchy of category identifiers (col. 26, lines 9-30, Wical).

Regarding claim 8, all the limitations of this claim have been noted in the rejection of claim 6. In addition, Wical discloses: wherein the ranking the category identifiers based on the types of the matches includes ranking the category identifiers based on whether the matches occur with at least one of the terms related to one or more categories or with the hierarchy of category identifiers (col. 27, lines 14-33, Wical).

Regarding claims 9 and 11, all the limitations of these claims have been noted in the rejection of claims 8 and 6 above, respectively. In addition, Wical discloses: wherein category identifiers that include matches that occur with both the hierarchy of category identifiers and the terms related to one or more categories are ranked higher than category identifiers that include matches that occur with only one of the hierarchy of category identifiers and the terms related to one or more categories (col. 25, lines 10-26, Wical).

Regarding claim 10, all the limitations of this claim have been noted in the rejection of claim 6. In addition, Wical discloses: wherein category identifiers that include matches that occur with more than one type are ranked higher than category identifiers that include matches that occur within only one of the types (col. 25, lines 10-26, Wical).

Regarding claim 12, all the limitations of this claim have been noted in the rejection of claim 6. In addition, Wical disclose: wherein the hierarchy of category identifiers comprises an ordered list of category names arranged in order from broad categories to narrow categories with

the narrowest category being a final category name (fig. 8a-8c, fig. 9c and corresponding text, Wical) such that category identifiers that include matches that occur with the final category name of the hierarchy of category names are ranked higher than category names that include matches that occur at a location other than the final category name (col. 23, lines 48-55, Wical).

Regarding claim 13, all the limitations of this claim have been noted in the rejection of claim 1. In addition, Wical discloses: wherein the items comprise web sites (col. 5, lines 47-60, Wical).

### **3. *Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

### **4. *Claims 14-20 and 22-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wical (U.S 5940821) in view of Snow et al. (U.S 6055540) (Snow).***

Regarding claims 14 and 25, all the limitations of these claims have been noted in the rejection of claim 1. However, Wical didn't disclose: comparing the search term with a list of recommended items to determine whether matches exist and comparing the search term with previously performed searches to determine whether matches exist. On the other hand, Snow disclose: comparing the search term with a list of recommended items to determine whether matches exist (col. 7, lines 66 to col. 8, lines 15, Snow) and comparing the search term with previously performed searches to determine whether matches exist (col. 8, lines 25-38, Snow).

Thus, at the time invention was made, it would have been obvious to a person of ordinary skill in the art to include comparing the search term with a list of recommended items to determine whether matches exist and comparing the search term with previously performed searches to determine whether matches exist in the system of Wical as taught by Snow. The motivation being to enable the user retrieves all the relevant results using query terms to compare with items for determine the relevant documents and avoid the relevant results may not be searchable.

Regarding claim 20, all the limitations of this claim have been noted in the rejection of claim 14. In addition, Wical/Snow discloses: wherein the items comprise web sites (col. 5, lines 47-60, Wical).

Regarding claims 22 and 26, all the limitations of these claims have been noted in the rejection of claim 21 and 25, respectively. In addition, Wical/Snow disclose: wherein the computer readable medium comprises a propagated signal (col. 13, lines 56-57, Snow). Thus, at the time invention was made, it would have been obvious to a person of ordinary skill in the art to include a propagated signal in the system of Wical as taught by Snow. The motivation being to enable the user to know the length of time to send and receive the electronic information in the network system.

Regarding claims 23 and 27, all the limitations of these claims have been noted in the rejection of claim 22 and 26, respectively. In addition, Wical/Snow disclose: wherein the propagated signal comprises a carrier wave (col. 13, lines 56-57, Snow).

Regarding claim 24, all the limitations of this claim have been noted in the rejection of claim 23.

In addition, Wical/Snow disclose: wherein items comprise web sites and the terms related to one or more categories (business) include a name and a description of a web site corresponding to a category (col. 5, lines 47 to col. 6, lines 41, Wical).

Regarding claims 15 and 28, all the limitations of these claims have been noted in the rejection of claims 14 and 27, respectively. In addition, Wical/Snow disclose: further comprising instructions for comparing the search term with an electronic information store that includes full text of different web pages from different web sites to determine whether matches exist (fig. 9B and corresponding text, Wical).

Regarding claims 16 and 29, all the limitations of these claims have been noted in the rejection of claims 15 and 28, respectively. In addition, Wical/Snow discloses: wherein the instructions for receiving at least one search term comprises: receiving several search terms (col. 9, lines 31-39, Wical); and grouping the search terms received as a single string (col. 9, lines 60 to col. 10, lines 30, Wical).

Regarding claims 17 and 30, all the limitations of these claims have been noted in the rejection of claims 15 and 28, respectively. In addition, Wical/Snow discloses: wherein the items comprise web sites and displaying results comprises displaying a list of recommended sites, a list of related searches, a list of category identifiers, and a list of web site identifiers (Fig. 10A, 10B, 11A, and 11B and corresponding text, Wical).

Regarding claims 18 and 31, all the limitations of these claims have been noted in the rejection of claims 15 and 28, respectively. In addition, Wical/Snow discloses: further

comprising conducting a World Wide Web search using the search term when less than a threshold number of matches occurs (col. 19, lines 26-44, Wical).

Regarding claims 19 and 32, all the limitations of these claims have been noted in the rejection of claims 18 and 31, respectively. In addition, Wical/Snow discloses: further comprising conducting a search of an electronic information store that includes full text of proprietary content (fig. 13 and corresponding text, Wical).

**5. New claim rejections.**

Regarding claims 33 and 34, all the limitations of these claims have been noted in the rejection of claims 1, 14, and 25. It is therefore rejected as set forth above.

**6. *Response to Argument (filed 09/24/2003)***

Applicant argues: Wical fails to describe or suggest a method/program for performing a category search that performs the recited two comparisons to identify matches of the search term, by matching the search term word with one or more words in the hierarchy of category identifiers and by matching the search term word with the terms related to one or more categories. In response, Wical clearly discloses: matching the search term word with one or more words in the hierarchy of category identifiers as query term “festivals” mapped into the category “customs and practices” in the “social sciences” (col. 18, lines 20-67, Wical) and by matching the search term word with the terms related to one or more categories as the search term word “festivals” mapped into the categories for matching the terms related see col. 19, lines 1-44, Wical).

Applicant argues: In Snow, no comparison between the search term and a list of recommended items is ever performed. In response, Snow clearly disclose: comparison between

the search term and a list of recommended items as the search terms are compared to each of the relevant document vectors see col. 8, lines 25-38, Snow.

Applicant argues: Snow does not disclose performing a comparing of the search term with previously performed searches to determine whether matches exist. In response, Snow clearly disclose: comparing of the search term with previously performed searches to determine whether matches exist once results are obtained, the user can then select one or more categories or modify the search terms to run a more limited search see col. 7, lines 45-61, Snow.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. *Contact Information*

Art Unit: 2171

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cindy Nguyen whose telephone number is 703-305-4698. The examiner can normally be reached on M-F: 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7240 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

*CN*

Cindy Nguyen  
November 10, 2003

*S. M*  
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